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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/311,173 05/13/99 ANDERSON

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EXAMINER
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LM02/0510

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ART UNIT	PAPER NUMBER
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2773

DATE MAILED:

05/10/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/311,173

Applicant(s)

Anderson

Examiner

Crescelle Dela Torre

Group Art Unit

2773



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. This action is responsive to communications: Preliminary Amendment, filed on 5/13/99.

This action is non-final.

2. Claims 1 - 27 are pending in this application. In the Preliminary Amendment, filed on 5/13/99, claims 28 - 49 were canceled.

This application is a continuation of 08/872,578, filed on 6/10/97, now U.S. patent no. 5,933,137.

3. The present title of the invention is "Method and Apparatus for Accelerating a User Interface of an Image Capture Unit During Play Mode".

### *Specification*

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

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*Claim Rejections - 35 U.S.C. § 112*

5. Claims 18, 20, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 18, should the depending claim be "17" instead of "16"?

*Double Patenting*

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 1 - 27 are rejected under the judicially created doctrine of double patenting over claims 1 - 9, 11, and 22 of U.S. Patent No. 5,933,137 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a "method for accelerating a user interface on a display of an image capture unit...", the method comprising the steps of "providing a low resolution image, medium resolution image and high resolution image within each image file": and "allowing the medium resolution image to be viewed on the display", as in claim 1 of the present invention and claim 6 (parts a and b), of the '137 patent. In addition, claims 2 - 6; 7 - 11; 12 - 16; 17 - 22; and 23 - 27; of the present invention are similar to claims 7, 11, 8, 22, 9: 1 - 5; 1 - 5; 6 (parts a and b), 7, 11, 8, 22, 9; and 1 - 5 of the '137 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 U.S.C. § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3, 5, 17, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lourette et al. (U.S. patent 5,978,016) in view of Kuchta et al. (U.S. patent 5,164,831).

As per claim 1, Lourette et al., hereinafter Lourette, describe a method for displaying images on a display of a image capture unit. at Fig. 3, with controls for allowing an image to be viewed, at Fig. 8, and for allowing navigation between plural images, at col. 15, lines 15 - 40, the method comprising the steps of:

(a) providing a low resolution image, medium resolution image, and high resolution image within each image file, at col. 3, lines 2 - 26, which describes first, second, and third digital images of varying resolution; and

(b) allowing the medium resolution image to be viewed on the display, at col. 3, lines 24 - 26, which describes that the second digital image can be selectively displayed.

Lourette teaches the above steps, but does not specifically teach doing so in order to "accelerate a user interface".

On the other hand, the display of reduced resolution images is known in the art. For instance, Kuchta et al., hereinafter Kuchta, teach a multi-format image file that is "formed by combining the (full resolution) digital image signals and the reduced resolution signals", and that

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the "image file is then stored in the digital memory, where the reduced resolution signals may be quickly accessed for rapid display" at col. 2, lines 44 - 48.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to view the reduced resolution images as in Kuchta because it provides for quicker review of images.

As to claim 3, Lourette teaches high, medium, and low resolution images, at col. 3, lines 2 - 26, and JPEG images, at col. 13, line 65, while Kuchta teaches thumbnail images, at col. 2, line 25.

Regarding claim 5, Kuchta teaches fetching the image, decompressing the image, and displaying the image, at Fig. 3A, and col. 7, lines 4 - 33.

As to claims 17, 19, and 21, they correspond respectively to claims 1, 3, and 5.

#### *Allowable Subject Matter*

10. Claims 2, 4, 6, 18, 20, and 22 are allowed over the art of record because none of the art of record disclose the claim limitations. In particular, although the Kuchta reference allows for navigation between reduced resolution images, at col. 2, lines 47 - 48, Kuchta does not specifically teach "causing the high resolution image within the same image file to be displayed on top of the medium resolution image dependent upon the quality of the medium resolution image" as in claims 2 and 18.

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11. Claims 2 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 7 - 11 and 23 - 27 are allowed over the art of record because none of the art of record disclose the claim limitations. In particular, as per claims 7 and 23, although the Kuchta reference provides a reduced resolution image associated with a high resolution image within a digital file format, and allows for viewing and navigating the reduced resolution images, at col. 2, lines 21 - 48, Kuchta does not specifically teach "causing the high resolution image related to the lower resolution image to be displayed on top of the lower resolution image dependent upon the quality of the lower resolution image".

13. Claims 12 - 16 are allowed over the art of record because none of the art of record disclose the claim limitations. In particular, as to claim 12, although the Kuchta reference provides a reduced resolution image associated with a high resolution image within a digital file format, and allows for viewing reduced resolution images, at col. 2, lines 21 - 48, Kuchta does not specifically teach "causing the high resolution image related to the low resolution image to be displayed on top of the low resolution image dependent upon the quality of the lower resolution image if the user has not scrolled to the next image".



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### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The additionally cited U.S. patent documents describe various systems and methods for displaying and/or processing images.

### *Responses*

15. Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 308-6606 for informal or draft communications.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

### *Inquiries*

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crescelle dela Torre whose telephone number is (703) 305-9782. The

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examiner can normally be reached on Mondays-Thursdays from 8:30 am to 4:00 pm, and on alternating Fridays from 8:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached at (703) 305-3821.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

*C. de la Torre*  
**CRESCELLE N. DELA TORRE**  
**PRIMARY EXAMINER**  
5/5/00